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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,043	11/04/2003	Derek Campbell	005127.00179	3120
22909 7590 07/07/2010 BANNER & WITCOFF, LTD. 1100 13th STREET, N.W. SUITE 1200 WASHINGTON, DC 20005-4051				
EXAMINER				
MAIL TRI M				
ART UNIT		PAPER NUMBER		
3781				
MAIL DATE		DELIVERY MODE		
07/07/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/700,043
Filing Date: November 04, 2003
Appellant(s): CAMPBELL ET AL.

Elizabeth A. Almeter
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 05/06/2010 appealing from the Office action mailed 10/15/2009.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 1, 2, 4-38, and 40-55 are rejected and presently appealed.

Claims 3, 39, and 61- 67 have been cancelled without prejudice or disclaimer.

Claims 56-60 and 68-76 have been withdrawn from consideration

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except

for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

6,938,762	Cheng	9-2005
6,736,264	Yoshida	5-2004
6,568,527	Te-Pin	5-2003
6,386,362	Cheng	5-2002
6,298,988	Wen-Chien	10-2001
2004/0200746	Kang	10-2004

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 1, 4-11, 15-16, 20-28, 33, 34, and 36 are rejected under 35 U.S.C. 102 (e) as being anticipated by Cheng (6938762). Cheng '762 teaches a golf bag having a base 20 including a one-piece element (col. 2, ln. 21) that extend around the second of the body and forms a support surface and defining a flexion line 224 defining two pivotable portions.

Regarding claim 7, there is a reduced thickness at the joint.

2. Claims 1, 6, 8-11, 15, 16, 18, 20-25, 33, and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Cheng (6386362). Cheng '362 teaches a golf bag having a base including a one-piece element 2 that extend around the second of the body and forms a support surface and defining a flexion line 42 defining two pivotable portions.

Cheng '362 teaches a one piece base with the pivot section 40 is molded together with the base:

a one-piece, molded, flexible pivot section including bridging portions bridging the V-shaped notches between the first and second upstanding walls, and **a rib portion extending between the bridging portions and pivotally connecting the first and second bottoms** whereby the first and second sections of the base seat may pivot relative to each other (claim 1, emphasis added)

The pivot section 40 is made by injection molding. The periphery of the pivot section 40 is bridged between the edges of the lateral side and bottom face of the adjacent open portions of the front and rear sections 20, 30 so as to connect the first and second receiving rooms 22, 32. The pivot section 40 is further formed with a rib 42 slightly projecting from inner bottom face of the base seat 2. The pivot section 40 is made of well flexible plastic or rubber material, whereby the front and rear sections 20, 30 can be swung about the pivot section 40 by a certain amplitude. (col. 3, ln. 11-20, emphasis added)

Even it is argued that Cheng '362 does not teach the base being single molded piece, the examiner submits that the base in Cheng '362 still anticipates the claims since the recitation "formed of a single piece" is broad and does not exclude the base made from a plurality of elements.

3. Claims 1, 4-11, 15-16, 18, 20-28, 33, 34, and 36 are rejected under 35 U.S.C. 102(c) as being anticipated by Te-Pin (6568527). Te-Pin teaches a golf bag having a base 1 (Fig. 1)

comprising a front section 11, a rear section 20 and a flexible section 50 joined the two sections forming a “single piece” as claimed.

The examiner submits that the recitation “formed of a single piece” is broad and does not exclude the base made from a plurality of elements.

4. Claims 2, 29-30, 38, 40-43, 46, and 47 are rejected under 35 U.S.C. 103 (a) as being unpatentable over anyone of Cheng ‘762, Cheng ‘362 and Te-pin ‘527 rejections as set forth in paragraphs 1-3, and further in view of Kang (2004/0200746). The Cheng ‘762, Cheng ‘362 and Te-pin ‘527 references, as applied in paragraphs 1-3 meets all claimed limitations except for the material for the base being made ethylvinylacetate foam (paragraph 51). Kang teaches that it is known in the art to make the base from ethylvinylacetate foam (para. 17). It would have been obvious to one of ordinary skill in the art to make the base of anyone of Cheng ‘762, Cheng ‘362 and Te-pin ‘527 from ethylvinylacetate foam to provide the desired material for the base.

5. Claims 12-14, 31-32, 35-37, 44, and 45 are rejected under 35 U.S.C. 103 (a) as being unpatentable over anyone of Cheng ‘762, Cheng ‘362 and Te-pin ‘527 rejections as set forth in paragraphs 1-3,, and further in view of Wen-Chien (6298988). The Cheng ‘762, Cheng ‘362 and Te-pin ‘527 references, as applied in paragraphs 1-4 meets all claimed limitations except for wear elements and the material being made from rubber.

Wen-Chien also teaches that it is known in the art to provide wear elements 19 and 20 for a base as shown in Fig. 3 in two different configurations, i.e., one being larger and having a different shape than the other. It would have been obvious for one of ordinary skill in the art to

provide wear elements in the base of anyone of Cheng '762, Cheng '362 and Te-pin '527 as taught by Wen-Chien, an alternative supporting means and or to keep the bag secured and to grip the standing surface easily.

With respect to the material being rubber, it would have been obvious to one of ordinary skill in the art to make the feet of Wen-Chien from rubber as claimed since rubber is a well known material for providing contact between objects and the ground.

6. Claims 17-19 are rejected under 35 U.S.C. 103 (a) as being unpatentable over anyone of Cheng '762, Cheng '362 and Te-pin '527 rejections as set forth in paragraphs 1-3, and further in view of Yoshida (6736264). The Cheng '762, Cheng '362 and Te-pin '527 references, as applied in paragraphs 1-3, each teaches the base as disclosed, but does not teach a handle. Yoshida teaches that it is known in the art to provide a handle for a golf bag. It would have been obvious to one of ordinary skill in the art to provide a handle in the golf bag of anyone of Cheng '762, Cheng '362 and Te-pin '527 as taught by Yoshida '264 to enable one to handle the golf bag easily.

7. Claims 48-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over anyone of Cheng '762, Cheng '362 and Te-pin '527 rejections as set forth in paragraphs 1-3, and further in view of Wen-Chien '988, and Kang '746. The Cheng '762, Cheng '362 and Te-pin '527 references, as applied in paragraphs 1-4, each teaches the base as disclosed, but does not teach the bottom being made from ethylvinylacetate foam and the wear elements. As applied supra, Kang '746 teaches that it is known in the art to make the base from ethylvinylacetate foam (para.

17). It would have been obvious to one of ordinary skill in the art to make the base of anyone of Cheng '762, Cheng '362 and Te-pin '527 from ethylvinylacetate foam to provide the desired material for the base.

With respect to the feet, Wen-Chien also teaches that it is known in the art to provide wear elements 19 and 20 for a base as shown in Fig. 3 in two different configurations, i.e., one being larger and having a different shape than the other. It would have been obvious for one of ordinary skill in the art to provide wear elements in the base of anyone of Cheng '762, Cheng '362 and Te-pin '527 as taught by Wen-Chien, an alternative supporting means and or to keep the bag secured and to grip the standing surface easily.

With respect to the material being rubber, it would have been obvious to one of ordinary skill in the art to make the feet of Wen-Chien from rubber as claimed since rubber is a well known material for providing contact between objects and the ground.

(10) Response to Argument

Appellant's arguments and the declaration filed 03/19/2007 have been fully considered but they are not persuasive.

A. Claims 1, 4-11, 15-16, 20-28, 33, 34, and 36 are rejected under 35 U.S.C. 102 (e) as being anticipated by Cheng (6938762).

A1. Appellant relies on the Declaration of the inventors under 37 CFR § 1.131 filed March 19, 2007 to establish a date of conception and reduction to practice prior to May 28, 2003.

37 CFR 1.131. Affidavit or declaration of prior invention.

(a) **When any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim,** the owner of the patent under reexamination, or the party qualified under § § 1.42, 1.43,

or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based. The effective date of a U.S. patent, U.S. patent application publication, or international application publication under PCT Article 21(2) is the earlier of its publication date or date that it is effective as a reference under 35 U.S.C. 102(e). Prior invention may not be established under this section in any country other than the United States, a NAFTA country, or a WTO member country. Prior invention may not be established under this section before December 8, 1993, in a NAFTA country other than the United States, or before January 1, 1996, in a WTO member country other than a NAFTA country. Prior invention may not be established under this section if either:

- (1) The rejection is based upon a U.S. patent or U.S. patent application publication of a pending or patented application to another or others which claims the same patentable invention as defined in § 41.203(a) of this title, in which case an applicant may suggest an interference pursuant to § 41.202(a) of this title; or
- (2) The rejection is based upon a statutory bar.

(b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. **Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained**

(emphasis added)

A2. In the affidavit, paragraph 4, appellant asserts that the invention in at least claims 1, 4-11, 15, 16, 20-28, 33, 34, and 36 was conceived and reduced to practice prior to May 28, 2003. The affidavit, paragraph 6, asserts that the conception and reduction to practice of a single piece base with an inside indentation in the base and pivotable about the flexion line for claims 1 and 20. Paragraph 7 asserts the conception and reduction to practice a single piece base for claims 4-11, 15, 16, 21-28, 33, 34, and 36. The examiner submits that the declaration, as a whole, is defective and cannot overcome the Cheng '762 reference. The declaration and exhibits fail to

show that the bottom is made from one piece. The exhibits appear to show that the bottom is made from a plurality of pieces or do not show enough detail to ascertain whether the bottom is of one piece or multiple pieces. Furthermore, the examiner submits that at least claims 25, 34, 36 are not supported at all by this assertion, i.e., none of the exhibit show the reduced thickness at the interface, and the shaft (22) extends between the upper portion and the base.

A3. Appellant also asserts that none of the independent claims recites the reduced thickness of the shaft and that would eliminate Cheng '762 as prior art. Even if the Board agrees to consider the affidavit over the independent claims, the examiner insists that some of the independent claims, not covered by the affidavit, are taught by Cheng '762. Without providing a table mapping the claims with the features supported by the evidence in the affidavit, as required in the office action dated 02/07/2008 (pg. 5), the examiner cannot determine the priority of each claim, even with the limitation that the base being formed of a single piece element is not clear from the evidence.

B. Claims 1, 6, 8-11, 15, 16, 18, 20-25, 33, and 34 are being rejected under 35 U.S.C. 102(b) as being anticipated by Cheng (6386362).

- B1. Appellant asserts that Cheng '362 fails to teach the base "formed of a single piece".
- B2. Cheng '362 clearly teaches a one piece base with the pivot section 40 is molded together with the base:

a one-piece, molded, flexible pivot section including bridging portions bridging the V-shaped notches between the first and second upstanding walls, and **a rib portion extending between the bridging portions and pivotally connecting the first and second bottoms** whereby the first and second sections of the base seat may pivot relative to each other (claim 1, emphasis added)

The pivot section 40 is made by injection molding. The periphery of the pivot section 40 is bridged between the edges of the lateral side and bottom face of the adjacent open portions of the front and rear sections 20, 30 so as to connect the first and second receiving rooms 22, 32. The pivot section 40 is further formed with a rib 42 slightly projecting from inner bottom face of the base seat 2. The pivot section 40 is made of well flexible plastic or rubber material, whereby the front and rear sections 20, 30 can be swung about the pivot section 40 by a certain amplitude. (col. 3, ln. 11-20, emphasis added)

- B3. Appellant asserts that the two halves must be connected by separate parts. The examiner submits that Cheng teaches a plurality of embodiments other than the anticipated embodiment where the flexible pivot section is molded together with the two halves as set forth above.
- B4. To the degree it is argued that Cheng '362 does not teach the base being a single molded piece, the examiner submits that the base in Cheng '362 still anticipates the claims since the recitation "formed of a single piece" is broad and does not exclude the base made from a plurality of elements. Furthermore, the specification uses the term "one-piece element" (pg. 5, para. 29) and sheds no light on the recitation "single piece collar".
- B5. The examiner submits the evidence from the Keller et al. (US 5501328), where in a "single piece collar" is made up from a plurality of parts.

FIG. 10 illustrates an alternative embodiment of the cover 28 wherein the inner and outer portions 30 and 32 thereof are joined together so that the cover 28 is made **as a one-piece item.** (col. 3, ln 13, **emphasis added**).

- B5. The base, as defined by specification of the present application, comprised of plurality of elements (pg. 9, par. 37):

Base 40 includes a contact element 30 and a plurality of connecting elements 60a-60t; as depicted in Figures 5-11C. (pg. 9, para. 37)

B6. It is also noted that the drawing of Fig. 8 and the affidavit show the base is made from a plurality of elements, e.g., exhibit C shows the durable inserts of rubber or harder phylon, exhibit D shows base with the internal pp frame, exhibit E shows the base with various inserts/parts, exhibit shows the base with external frame. The examiner submits that the recitation "single piece element" must be interpreted as "a one-piece item" which is comprised of a plurality of elements as set forth in the specification.

Issue C: Claims 1, 4-11, 15-16, 18, 20-28, 33, 34, and 36 are rejected under 35 U.S.C. 102(e) as being anticipated by Te-Pin (6568527).

C1. Appellant rehashes the same argument that the base of Te-Pin does not teach the base being formed of a single piece element. The examiner submits that the term "single piece" does not read over the base of Te-Pin. Te-Pin teaches a front section 11, a rear section 20 and a flexible section 50 joined the two sections forming a "single piece" as claimed.

Issue D: Claims 2, 29-30, 38, 40-43, 46, and 47 are rejected under 35 U.S.C. 103 (a) as being unpatentable over any of the Cheng '762, Cheng '362, and Te-pin '527 rejections as set forth in issues A, B, and C, and further in view of Kang (2004/0200746).

D1. Kang teaches that it is known in the art to make the base from ethylvinylacetate foam (para. 17). Therefore, it would have been obvious for one of ordinary skill in the art to make the lower base segment from ethylvinylacetate foam to provide the desired material for the base.

D2. This issue stands or falls together with any of the rejections of Cheng '762, Cheng '362 and Te-pin '527 set forth in issues A, B, and C.

Issue E: Claims 12-14, 31-32, 35-37, 44, and 45 are rejected under 35 U.S.C. 103 (a) as being unpatentable over any of the Cheng '762, Cheng '362, and Te-pin '527 rejections as set forth in issues A, B, and C, and further in view of Wen-Chien (6298988).

E1. Wen-Chien also teaches that it is known in the art to provide wear elements 19 and 20 for a base as shown in Fig. 3 in two different configurations, i.e., one being larger and having a different shape than the other. It would have been obvious for one of ordinary skill in the art to provide wear elements as taught by Wen-Chien, an alternative supporting means and or to keep the bag secured and to grip the standing surface easily.

E2. This issue stands or falls together with any of the rejections of Cheng '762, Cheng '362 and Te-pin '527 set forth in issues A, B, and C.

Issue F: Claims 17-19 are rejected under 35 U.S.C. 103 (a) as being unpatentable over any of the Cheng '762, Cheng '362, and Te-pin '527 rejections as set forth in issues A, B, and C, and further in view of view of Yoshida (6736264).

F1. Yoshida teaches that it is known in the art to provide a handle for a golf bag. It would have been obvious to one of ordinary skill in the art to provide a handle as taught by Yoshida '264 to handle the golf bag easily.

E2. This issue stands or falls together with any of the rejections of Cheng '762, Cheng '362 and Te-pin '527 set forth in issues A, B, and C.

Issue G: Claims 48-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over any of the Cheng '762, Cheng '362, and Te-pin '527 rejections as set forth in issues A, B, and C, and further in view of Wen-Chien '988, and further in view of either Kang '746.

G1. Claim 48 set forth the first wear element has a first configuration and the second wear element has a second element. Appellant asserts that Wen-Chien '988 and Kang '746 fail to teach the first and second wear elements.

G2. As discussed supra, Wen-Chien teaches that it is known in the art to provide wear elements 19 and 20 for a base as shown in Fig. 3 in two different configurations, i.e., one being larger and having a different shape than the other.

G3. The examiner also submits that the specification fails to shed light in what is meant by "first configuration" and "second configuration" other than the different shapes that is presented in the drawings. In this respect, the term "configuration" is interpreted as having a specific shape. Wen-Chien teaches the two configurations as claimed.

G4. With respect to the limitation of the base being formed from a polymer foam material, the examiner submits that Kang teaches the base is formed from foam, paragraphs 16 and 17.

(11) Related Proceeding(s) Appendix

Art Unit: 3781

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Tri M Mai/

Primary Examiner, Art Unit 3781

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/Nathan J. Newhouse/

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